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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/560,834

02/28/2007

Johann Manner

4838-001

6903

22429

7590

03/24/2010

LOWE HAUPTMAN HAM & BERNER, LLP  
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EXAMINER

JUSKA, CHERYL ANN

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

03/24/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/560,834	MANNER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Cheryl Juska	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-8,10 and 12 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-8 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 17, 2010 has been entered.

### ***Response to Amendment***

2. Applicant's amendment filed with the RCE has been entered. Claim 1 has been amended as requested. Claims 5, 9, and 11 have been cancelled, while new claim 12 has been added. Thus, the pending claims are 1-4, 6-8, 10, and 12.

3. Said amendment is sufficient to withdraw the 112, 2<sup>nd</sup> and 101 rejections set forth in sections 3-7 of the last Office Action (Final Rejection mailed 08/19/2009). Additionally, said amendment is sufficient to withdraw the 102/103 rejection of the claims as set forth in sections 9 and 10 of the last Office Action.

### ***Election/Restrictions***

4. Newly submitted claim 12 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 12 is drawn to a final product (i.e., carpet), while the examined claims are method claims.

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5. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 12 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

6. Claims 1-4, 6-8, and 10 stand rejected under 35 U.S.C. 103(a) as obvious over US 6,235,392 issued to Luo et al. as set forth in section 12 of the last Office Action.

Applicant has amended claim 1 so that the use of the fiber in the recited applications is an active method step. As such, said use is now given patentable weight and the claims stand rejected as set forth in the alternate obviousness rejection (section 12 of the last Office Action).

To reiterate, while Luo fails to teach the use of said fibers in the specifically recited applications, the reference does teach teaches the lyocell fibers are used to make yarns, woven fabrics, and/or nonwoven fabrics (abstract and col. 1, lines 9-12). The recited applications of carpets, textile flooring materials, wall linings, and/or decoration materials are known to make use of regenerated cellulose fibers. [Applicant was previously given Official Notice of this fact. Note since applicant failed to traverse the Official Notice given in the prior Office Action, the fact is now taken as admitted prior art. See MPEP 2144.03, C.] As such, it would have been readily obvious to one skilled in the art to employ the lyocell fibers of Luo in said applications.

Regarding the claimed ratio V, said ratio would have necessarily been present in the lyocell fibers taught by Luo. Note Luo discloses fibers having a denier of 3.1-19.5 (3.4-21.7

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dtex) (col. 11, lines 13-22). Luo's range of fiber titer overlaps with applicant's claimed range by the range of 6-21.7 dtex, wherein fibers of this titer range will necessarily possess the claimed ratio V. Like materials cannot have mutually exclusive properties. Therefore, claims 1-4, 6-8, and 10 stand rejected as being obvious over the cited prior art.

### *Response to Arguments*

7. Applicant's arguments filed with the amendment of 02/17/2010 have been fully considered but they are not persuasive.

8. Applicant argues the claims are patentable based upon the unexpected results described in the Declaration of Johann Manner filed on 02/17/2010 with the RCE (Remarks, page 5, 2<sup>nd</sup> paragraph). Specifically, applicant asserts the ratio V surprisingly and suddenly drops down to values of 2.2 or less at a titer of more than 6 dtex (Annex 1 of Declaration). Applicant concludes, "This is not expected and without this discovery being made, the claimed subject matter cannot be held to be 'inherent' in the manner advanced in this rejection" (Remarks, page 5, 3<sup>rd</sup> paragraph). This argument is unpersuasive since discovery or recognition of an inherent property is not invention. Luo teaches claimed lyocell fibers having a titer range which overlaps applicant's claimed range. Said fibers will inherently possess the claimed ratio V since like materials cannot have mutually exclusive properties. Applicant's Declaration has not shown the lyocell fibers disclosed by Luo having a titer of 6-21.7 dtex do not possess the claimed ratio V. Nor, has applicant shown that the present lyocell fibers having the claimed titer are structurally or chemically different than those disclosed by Luo. As such, applicant's Declaration is insufficient to overcome the prior art rejection.

*Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner can be emailed at [cheryl.juska@uspto.gov](mailto:cheryl.juska@uspto.gov) or the examiner's supervisor, D. Lawrence Tarazano can be reached at 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Cheryl Juska/*  
Primary Examiner  
Art Unit 1794

cj  
March 25, 2010